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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,392	07/03/2003	Ronald J. Rosenberger		7234
7590 Ronald Rosenberger 506 Sterling St. Newtown, PA 18940				
		EXAMINER MYHRE, JAMES W		
		ART UNIT 3688		
		MAIL DATE 03/14/2008		
		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/613,392

**Applicant(s)**

ROSENBERGER, RONALD J.

**Examiner**

JAMES W. MYHRE

**Art Unit**

3688

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-6, 14, 15, 20 and 43-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 14, 15, 20 and 43-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is in response to the Amendment filed on January 22, 2008. The amendment cancelled Claims 3, 7-13, 16-19, and 21-42, added new Claims 43-50, and amended Claims 1, 2, 4-6, 14, 15, and 20. Thus, the currently pending claims considered below are Claims 1, 2, 4-6, 14, 15, 20, and 43-50.

### ***Specification***

2. The Amendment filed on January 22, 2008 corrected the title to properly reflect the claimed invention. Therefore, the Examiner hereby withdraws the objection to the title in paragraph 2 of the September 12, 2007 Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The Amendment filed on January 22, 2008 corrected the deficiencies in Claims 4-21 and 25-42 noted in paragraph 4 of the September 12, 2007 Office Action. Therefore, the Examiner hereby withdraws those rejections.

### ***Claim Rejections - 35 USC § 101***

4. The Amendment filed on January 22, 2008 corrected the deficiencies in Claims 2-10, 15-20, 23-31, and 36-41 noted in paragraph 5 of the September 12, 2007 Office Action. Therefore, the Examiner hereby withdraws those rejections.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-6, 14, 15, 20, and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manchester et al (US 2003/0204470) in view of Postrel (US 2005/0021400).

Claims 1 and 43: Manchester discloses a system and method, comprising:

- a. distributing applications containing a promoter code to users and receiving/processing completed applications (page 1, paragraph 0009 and page 2, paragraph 0017);
- b. establishing an account (with a "cooperating financial institution that is issuing the dual credit card as a bankcard") for a user based on the application and promoter (merchant) code (page 1, paragraph 0009 and page 2, paragraph 0017); and
- c. sending advertisements to the user based on the promoter code (page 1, paragraph 0012 and page 2, paragraph 0024).

While Manchester does not explicitly disclose storing a file (database) containing the advertisements being sent to the user, nor explicitly a database containing the promoter codes, Postrel discloses a similar system and method in which a database

has been established for storing advertisements to be sent to the user of the credit card based on the credit card's sponsor (promoter) (page 8, paragraph 0081). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Manchester to have established a database to store the advertisements being sent to the users and a database for storing the promoter codes for identifying the sponsors of the credit cards. One would have been motivated to establish these databases in order to allow Manchester to select the appropriate advertisement to send to the user, even if the promoter was not connected to the network at that specific time.

The Examiner notes that the newly added "wherein" clause at the end of Claim 1 (and reflected in the corresponding system claim, Claim 43) states that the promoter and the (account) offering entity are different and that the offering entity is not a financial card merchant. Manchester discloses that the account issuer in a financial institution and that the promoter is a merchant. Thus the two entities are different. As per the limitation that the issuing entity is not a financial card merchant, the Examiner interprets a financial card merchant as an entity that is in the business of "selling" financial cards, not an entity that issues financial cards itself. Furthermore, in Claims 4 and 45, dependent upon Claims 1 and 43, respectively, the account is identified as a "financial card account"; thus, the Applicant's offering entity is a financial card issuer, which Manchester explicitly discloses.

Claims 2 and 44: Manchester and Postrel disclose a system and method as in Claims 1 and 43 above, and Manchester further discloses that the steps are performed by the

offering entity. The Examiner notes that the Applicant is claiming that the entity could be the offering entity or a third party entity retained by the offering entity. While Manchester explicitly discloses the offering entity performing the steps, it would have also been obvious that the offering entity could delegate (outsource) the responsibility to a third party in order to eliminate the need for the bank (offering entity) in Manchester to have a separate department for issuing, processing, and reporting financial card accounts.

Claims 4-6 and 45-47: Manchester and Postrel disclose a system and method as in Claims 1 and 43 above, and Manchester further discloses the account relates to a financial card account and further discloses sending various type of promotional and personal messages (page 1, paragraph 0009 and 0012, and page 2, paragraph 0024).

Claims 14 and 48: Manchester and Postrel disclose a system and method as in Claims 1 and 43 above. While neither of the references explicitly disclose that the advertisements will be presented to the user for a limited time period, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set a time limit for the inclusion of the advertising. One would have been motivated to set a time limit in order to present current, pertinent information, e.g. not send a New Year's greeting in July.

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Claims 15 and 49: Manchester and Postrel disclose a system and method as in Claims 1 and 43 above. While neither reference explicitly discloses the offering entity charging a fee to the promoter (sponsor), it would have been obvious to one having ordinary skill in the art at the time the invention was made to charge the promoter a fee. One would have been motivated to charge the promoter a fee as it is common practice in the marketing art to charge an advertiser a fee for placing their advertisement in front of a consumer.

Claims 20 and 50: Manchester and Postrel disclose a system and method as in Claims 1 and 43 above, and Postrel further discloses the files being able to be added to, modified, or deleted by the entities (page 3, paragraph 0032 and page 6, paragraph 0066). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the promoter (merchant) in Manchester to access the files in order to add, delete, or amend the promotional material being included on the statement. One would have been motivated to allow the promoter to do this in order to keep the information current, i.e. not send a New Year's greeting in July.

### ***Response to Arguments***

7. Applicant's arguments filed January 22, 2008 have been fully considered but they are not persuasive.

The Applicant's argues in reference to Claim 1 that Manchester does not disclose that the promoter and the offering entity are different (pages 12-14). However, as

discussed in further detail in the above rejection, Manchester discloses a bank issuing a dual purpose credit card (i.e. the bank is the offering entity) and providing promotional material along with the credit card statements pertaining to the merchant (i.e. promoter) who is the "private label" part of the credit card. Thus, the servicing offering entity is the bank, and the promoter is the merchant.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is



(571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM  
March 5, 2008

/James W Myhre/  
Primary Examiner, Art Unit 3688